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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☒ Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1771

1. 35 U.S.C. § 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. § 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: At page 3, line 11 and elsewhere the term "pressure sensitively adhesively" is found in several places in the application and is clearly informal. Additionally, it is further noted that applicants use both the terms "pressure sensitive adhesive", "self-adhesive", and "cold seal" composition almost interchangeably to define their claimed adhesive composition, which leads to confusion. Additionally, at page 3, lines 15-17 refer to both the "main claim" and "the subclaims" in the specification as part of the description, which is clearly informal. Additionally, at page 15, the description of the "backing material A" and "backing material B" are essentially exact duplicates except for the recitation of the order of the SEBS and/or SEPS triblock copolymers. Finally, in Examples 2-5 it appears that the numeric values for the various ingredients are parts by weight, but nowhere is this specifically stated.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly

Art Unit 1771

claiming the subject matter which the applicants regard as their invention.

3. Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, the claims are clearly written in a very informal matter, containing what appears to be many translation related informalities and other foreign practice "formalities, despite the changes made in the preliminary amendment of November 5, 2001. For example, in claim 1 it is not clear whether applicants are claiming a backing material, or a form of medical tape coated with a latex free cold seal composition. Additionally, the use of "pressure-sensitively adhesive" which also appears to read upon the latex free cold seal composition is clearly confusing and no definition of the "tan δ" is also clearly confusing. In the dependent claims there are multiple ranges in many of the claims, the lack of Markush language and many other informalities which essentially leave the claims to be at the very least, extremely confusing in their present form.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences

Art Unit 1771

between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0826380A2 combined with the disclosure of its German counterpart DE 19631422 at pages 2-3 of the specification, or EP 0885942A1 combined with applicants' disclosures at page 2 fourth complete paragraph of the specification, each taken individually or in view of applicants' admissions set forth at page 1, second paragraph of the specification. Each of the two "primary references", discloses (EP -380, the entire Abstract; EP -942, the Abstract, page 3 line 56, page 4 line 33, page 4 lines 40-42, the Examples, claims 1-3, 8, and 12-16) hot melt adhesive compositions based upon block copolymers of the A-B or A-B-A type, in which A can be ~~poly~~styrene and B either propylene, butadiene, isoprene or various mixtures are disclosed. In particular, applicants' specification admits that EP -942 discloses both SEPS or SEBS block copolymers such as applicants contemplate and each reference teaches the use of block copolymers having a styrene content of the order contemplated by applicants. Additionally, ingredients such as the presence of tackifiers and other additives well known in the art may also be utilized, and each

Art Unit 1771

reference clearly teaches or is (EP -380) admitted by applicants as capable of being bonded to the skin in order to secure the article for a desired period of time without adhesive transfer or skin irritation (EP -942, Abstract). Accordingly, the Examiner takes the position that if the various parameters claimed by applicants are not inherently present, they would at most be an obvious optimization to one of ordinary skill, motivated by the expectation of desired adhesion values on the skin or other chosen substrate which can arise during medical practice.

Alternatively, applicants further have admitted (page 1, second paragraph) that what appears to be in essence the entire claimed invention is known except for the presence of a suitable cold seal composition based on the parameters set forth in applicants' claim 1, instead of the cold seal composition based on natural rubber. Accordingly, one of ordinary skill, motivated by the aforementioned expectation of improved bonding properties in a medical adhesive environment would have ample motivation to incorporate the adhesive compositions set forth in each of the secondary references into the admitted existing structures already known and thereby either form, or clearly render obvious, the claimed genus of medical articles. With respect to the dependent claims, if the various elements set forth therein are not either expressly or inherently disclosed, they are each believed to be well known optimization parameters or involve

Art Unit 1771

processing techniques that are well known to one of ordinary skill, in the absence of unexpected results.

6. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Note also Gobran, WO 97/43993, and Pike et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

July 9, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900

1700

Daniel Zirker